

permitted in patent applications. Working examples correspond to work actually performed and may describe tests which have actually been conducted and results that were achieved. Paper examples describe the manner and process of making an embodiment of the invention which has not actually been conducted. Paper examples should not be represented as work actually done. No results should be represented as actual results unless they have actually been achieved. Paper examples should not be described using the past tense.

For problems arising from the designation of materials by trademarks and trade names, see [MPEP § 608.01\(v\)](#).

#### **608.01(q) Substitute or Rewritten Specification**

*37 CFR 1.125. Substitute specification.*

(a) If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof, be rewritten.

(b) A substitute specification, excluding the claims, may be filed at any point up to payment of the issue fee if it is accompanied by:

(1) A statement that the substitute specification includes no new matter; and

(2) A marked-up copy of the substitute specification showing the matter being added to and the matter being deleted from the specification of record.

(c) A substitute specification submitted under this section must be submitted in clean form without markings as to amended material.

(d) A substitute specification under this section is not permitted in a reissue application or in a reexamination proceeding.

The specification is sometimes in such faulty English that a new specification is

necessary; in such instances, a new specification should be required.

Form Paragraph 6.28 may be used where the specification is in faulty English.

¶ 6.28 *Idiomatic English*

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

37 CFR 1.125(a) applies to a substitute specification required by the Office. If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof be rewritten.

Form Paragraph 6.28.01 may be used where the examiner, for reasons other than faulty English, requires a substitute specification.

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¶ 6.28.01 *Substitute Specification Required by Examiner*

A substitute specification [ 1 ] the claims is required pursuant to 37 CFR 1.125(a) because [ 2 ].

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

**Examiner Note**

1. In bracket 1, insert either -- excluding-- or -- including--.
2. In bracket 2, insert clear and concise examples of why a new specification is required.
3. A new specification is required if the number or nature of the amendments render it difficult to

consider the application or to arrange the papers for printing or copying, 37 CFR 1.125.

4. See also form paragraph 13.01 for partial rewritten specification.

5. 37 CFR 1.125(b) provides applicants with the right of entry of substitute specifications, under the conditions set forth in the section, in applications other than reissue applications (37 CFR 1.125(d)) that have not been required by the examiner.

37 CFR 1.125(b) applies to a substitute specification voluntarily filed by the applicant.

A substitute specification, excluding claims, may be voluntarily filed by the applicant at any point up to the payment of the issue fee provided it is accompanied by (1) a statement that the substitute specification includes no new matter, and (2) a marked-up copy of the substitute specification showing the matter being added to and the matter being deleted from the specification of record. 37 CFR 1.125(b). The Office will accept a substitute specification voluntarily filed by the applicant if the requirements of 37 CFR 1.125(b) are satisfied.

37 CFR 1.125(c) requires a substitute specification filed under 37 CFR 1.125(a) or (b) be submitted in clean form without markings as to amended material.

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A substitute specification filed under 37 CFR 1.125(b) must be accompanied by a statement indicating that no new matter was included. There is no obligation on the examiner to make a detailed comparison between the old and the new specifications for

determining whether or not new matter has been added. If, however, an examiner becomes aware that new matter is present, objection thereto should be made.

The filing of a substitute specification rather than amending the original application has the advantage for applicants of eliminating the need to prepare an amendment of the specification. If word processing equipment is used by applicants, substitute specifications can be easily prepared. The Office receives the advantage of saving the time needed to enter amendments in the specification and a reduction in the number of printing errors. A substitute specification is not permitted in a reissue application or in a reexamination proceeding. 37 CFR 1.125(d).

A substitute specification \*\*which complies with 37 CFR 1.125 should normally be entered. The examiner should write "Enter" or "OK to Enter" and his or her initials in ink in the left margin of the first page of the substitute specification. A substitute specification which is denied entry should be so marked.

Form Paragraph 6.28.02 may be used to notify applicant that a substitute specification submitted under 37 CFR 1.125(b) has not been entered.

¶ 6.28.02 *Substitute Specification Filed Under 37 CFR 1.125(b) Not Entered.*

The substitute specification filed [ 1 ] has not been entered because it does not conform to 37 CFR 1.125(b) because: [ 2 ]

**Examiner Note**

1. In bracket 2, insert statement of why the substitute specification is improper, for example:
  - the statement as to a lack of new matter under 37 CFR 1.125(b) is missing--,
  - a marked-up copy of the substitute specification has not been supplied (in addition to the clean

copy)--;

-- a clean copy of the substitute specification has not been supplied (in addition to the marked-up copy)--; or,

-- the substitute specification has been filed:

- in a reissue application or in a reexamination proceeding, 37 CFR 1.125(d)-, or
- after payment of the issue fee-, or
- containing claims (to be amended)- --.

See MPEP § 714.20 regarding entry of amendments which include an unacceptable substitute specification.

For new matter in amendment, see MPEP § 608.04.

For application prepared for issue, see MPEP § 1302.02.

#### **608.01(r) Derogatory Remarks About Prior Art in Specification**

The applicant may refer to the general state of the art and the advance thereover made by his or her invention, but he or she is not permitted to make derogatory remarks concerning the inventions of others. Derogatory remarks are statements disparaging the products or processes of any particular person other than the applicant, or statements as to the merits or validity of applications or patents of another person. Mere comparisons with the prior art are not considered to be disparaging, per se.

#### **608.01(s) Restoration of Canceled Matter**

Canceled text in the specification can be reinstated only by a subsequent amendment